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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/692,793
Filing Date: October 27, 2003
Appellant(s): LEE ET AL.

Cynthia K. Nicholson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/05/1998 appealing from the Office action mailed 1/23/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US006877137B1	Rivette et al	Filed 12/07/1999
US006687878B1	Eintracht et al	Filed 03/15/1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 6-10, 13-18, 20-28 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rivette'137** et al. US006877137B1- filed 12/07/1999 [hereinafter Rivette'137], in view of **Eintracht** et al. US006687878B1- filed 03/15/1999 [hereinafter Eintracht].

*Regarding **independent claim 1,***

Rivette'137 teaches:

an annotation component configured to determine, responsive to at least one user, at least one annotation to be applied to at least one document, including a selection resource to select at least a portion of the at least one document and to associate the at least one annotation therewith.

Specifically Rivette'137 discloses web annotation system (item 502 Fig. 5) the plurality components (items 504-509, fig. 5) for Web annotation (Rivette'137, col. 13, lines 5-10). In addition Rivette'137 discloses user interface (item 504, fig. 5) creates, updates, and

deletes objects in the Web annotation system 502 preferably using the COM interfaces (Rivette'137, col. 17, lines 10-20).

Furthermore Rivette'137 discloses web annotation system using Component Object Model, Jscript or DHTML component for controlling annotation system. Whereby enable a user to create an annotation to a web page, and links the annotation to the selected portion (Rivette'137 at col. 4, line 60 through col. 5 and Fig. 10 items 502, 1014A, 1016A and 1020A-1022B).

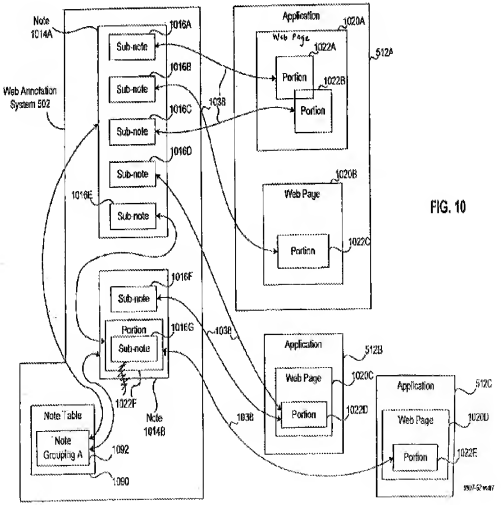

FIG. 10

Furthermore Rivette'137 teaches:

The annotation is image data or text, wherein each annotation can be different from every other annotation;

For example, Rivette'137 discloses in FIG. 5 the Web annotation system 502, includes a Web page's images or its text (see Rivette'137 Column 11, Lines 40-45).

Also, See Rivette' 137, Column 7, Lines 45-55, teaches product (CPP) for attaching annotations (or notes and sub-notes) to different data object portions as required by the needs of the user.

Furthermore Rivette'137 teaches:

a reference component, responsive to the at least one user, configured to at least one of establish, traverse, indicate, and remove, at least one reference between the at least one portion and at least one of an other portion of the at least one document, an other document, and at least one other portion of the other document.

Specifically Rivette'137 discloses a user interface for accessing and traverse the function provides by the web annotation system item 502 (Rivette'137, col. 31, lines 5-25). Also Rivette'137 discloses portions of Web pages can be stored at a Web site or in a local file system. The method of linking notes to web pages operates by enabling a user to select a portion of a Web page, creating a annotation, linking the annotation to the selected portion, receiving a request from a user viewing the annotation to display the selected portion linked to the annotation, and invoking an application, and for

causing the application to load the Web page and present the selected portion (Rivette'137 at the Abstract).

In addition Rivette'137 teaches:

a mark-up resource to at least one of add and edit the at least one annotation.

For example Rivette'137 discloses creating an annotation, linking the annotation to the selected portion, receiving a request from a user viewing the annotation to display the selected portion linked to the annotation, and invoking an application, and for causing the application to load the Web page and present the selected portion (Rivette'137 at the Abstract).

Rivette'137 teaches:

to retrieve at least one document from the first data storage as document data.

For example Rivette'137 discloses portions of Web pages can be stored at a Web site or in a local file system (Rivette'137 at the Abstract).

In addition Rivette'137 teaches:

to retrieve the at least one annotation be applied to said at least one document from a second storage as annotation data.

For example Rivette'137 discloses receiving a request from a user viewing the annotation to display the selected portion linked to the annotation, and invoking an application, and for causing the application to load the Web page and present the selected portion (Rivette'137 at the Abstract).

In addition, Rivette'137 does not explicitly teach, but Eintracht teaches:

at least one merge component configured to combine the annotation:

(See Eintracht at Fig. 3, and 8 and at Column 15, Line 60→Column 16, Line 10, discloses the annotation Session: includes synchronization of notes and merges the note event information with the server and/or local Notes Database.

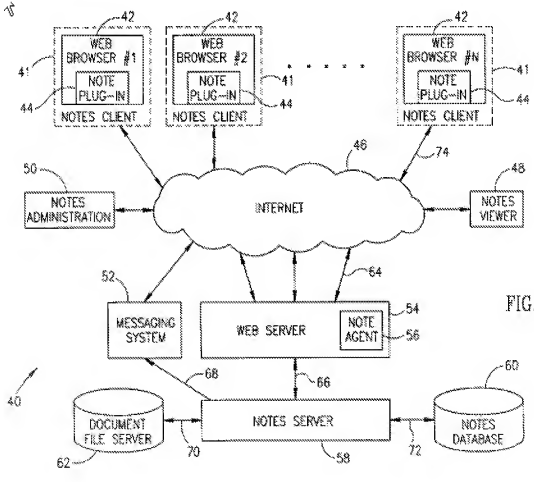

FIG.3

combine the annotation data and the document data to form a unitary single logical document, the single logical displaying the annotation data embedded seamlessly in the document data,

(See Eintracht at Fig. 3, and 8 and at Column 15, Line 60→Column 16, Line 10, discloses the annotation Session: includes synchronization of notes and merges the note event information with the server and/or local Notes Database.

Also See Eintracht at Column 2, Lines 15- 55, further discloses a notes client/server notes databases (i.e. notes markup resources), that includes the client software application, which is implemented as a web browser plug-in module. The plug-in contains the user interface for navigating *within the document and for handling the notes*. This allows the annotations are transmitted from the server independent of the data transmitted that is related to the viewed document. At the client side, the client application layers the annotations over the image (or document) in accordance with the coordinates of each. This allows the notes merge and the notes are combined with the document data to form a unitary single logical document - See Eintracht at Fig. 3, and 8 and at Column 1, Lines 50-60.

Using the broadest reason able interpretation, the Examiner reads the claimed **unitary single logical document, and annotation data embedded seamlessly in the document data** as equivalent to the client application layers the annotations over the image (or document) in accordance with the coordinates of each using the synchronization of notes process as taught by Eintracht. This interpretation is supported by the Applicant's disclosure, which states, "*The annotation merge component 307*

issues a request to retrieve these two (or more) documents. Consider that one of these, for illustration purposes, is a patent document and the other is annotation data marking up the patent. "_ See Applicant's Specs at Page 33 Lines 13-18.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified the teaching of Rivette'137, to include at least one merge component configured to combine the annotation data and the document data to form a unitary single logical document, the single logical displaying the annotation data embedded seamlessly in the document data as taught by Eintracht, to archive a predictable result of combining the notes with the document data to form a unitary single logical document - See Eintracht at Fig. 3, and 8 and at Column 1, Lines 50-60.

*Regarding **independent claim 18**,*

the rejection of claim 1 is fully incorporated, similarly rejected along the same rationale. In addition Rivette'137 teaches:

document data including at least one element corresponding to a location of the at least one annotation within said document.

For example Rivette discloses the bi-directional hyperlink that a user associates with the part of the Web page he/she has selected (Rivette'137 at col. 10, lines 30-35). Also Rivett'137 discloses Hypertext Markup Language (HTML) - see Rivette'137 at col. 2, lines 20-35).

Using the broadest reasonable interpretation, the examiner equates Rivett'137 teaching of Hypertext Markup Language (HTML) to the claimed invention, because it is the authoring language used to create documents or pages accessible on the Web, whereby Hyperlinks are a common function of the Internet (a hyperlink is an element in an electronic document that links to another place in the same document or to an entirely different document in the Web environment).

Furthermore Rivette'137 teaches:

> **at least one version component, configured to at least one of manage a history of changes and to maintain a separate version for the document data and the annotation data to be applied thereto;**

Specifically Rivette'137 discloses notes can be grouped together under one note grouping, note table (item 1090) or other database construct is used to keep track of which notes are in which note groupings (Rivette'137 at col. 18, lines 55-60 fig. 10 item 502 and 1090).

In addition, Rivette'137 does not explicitly teach, but Eintracht teaches:

> **at least one split component, configured to update the at least one annotation in the first data storage from the extracted annotation data, and to update the at least one document in the second data storage from the extracted document data.**

(See Eintracht at Column 3, Lines 35-50, discloses a system a system for annotating documents comprising a document file and notes database located on

the server, each note associated with a particular document, the notes server operative to store the documents in the document file SEPARATELY from notes stored in the notes database, the notes server receiving one or more notes associated with a particular document from the one or more notes clients and synchronization means within the notes clients and the notes server, the synchronization means for updating the notes server with any notes events processed by the notes clients and for updating the notes client with the results of synchronization updates previously performed by other notes clients since the last synchronization event.

Using the broadest reasonable interpretation, the Examiner equates the claimed **split component… update the at least one document in the second data storage from the extracted document data** as equivalent to store the documents in the document file SEPARATELY from notes stored in the notes database and he synchronization means for updating the notes server with any notes events processed by the notes clients and for updating the notes client with the results of synchronization updates previously performed by other notes clients since the last synchronization event as taught by Eintracht.

This allows independent management associated annotations to a particular document are treated independently from each other- see Eintracht Column 2, Lines 5-15. This interpretation is supported by the Applicant's disclosure, which states, " *the present invention provides for at least one split component, responsive to the marked-up representation, to extract the annotation data and the document data from the marked-up representation*" see the Applicant Specs Page 6, Line 10-12.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified the teaching of Rivette'137, to include at least one split component, configured to update the at least one annotation in the first data storage from the extracted annotation data, and to update the at least one document in the second data storage from the extracted document data as taught by Eintracht, to archive a predictable result of combining the notes with the document data to form a unitary single logical document - See Eintracht at Fig. 3, and 8 and at Column 1, Lines 50-60.

*Regarding **independent claim 25**,*

the rejection of claims 1 and 18 are fully incorporated, similarly rejected along the same rationale. In addition Rivette'137 teaches:

in the computer system and in responsive to user.

Specifically Rivette'137 discloses a web annotation system (item 502 Fig. 5) the plurality components (items 504-509, fig. 5) for Web annotation (Rivette'137, col. 13, lines 5-10). In addition Rivette'137 discloses user interface (item 504, fig. 5) creates, updates, and deletes objects in the Web annotation system 502 preferably using the COM interfaces (Rivette'137, col. 17, lines 10-20).

Using the broadest reasonable interpretation, the examiner equates, the claimed **in responsive to user in the computer system** to Rivette'137 suggests of the user interface of fig. 10 of Rivette'137.

Claim 2,

Rivette'137 teaches:

a view component operatively connected to the annotation to edit, responsive to the at least one user, the at least one portion of the at least one document selected by the selection resource.

Specifically Rivette'137 discloses a web annotation system (item 502 Fig. 5) the plurality components (items 504-509, fig. 5) for Web annotation (Rivette'137, col. 13, lines 5-10). In addition Rivette'137 discloses user interface (item 504, fig. 5) creates, updates, and deletes objects in the Web annotation system 502 preferably using the COM interfaces (Rivette'137, col. 17, lines 10-20).

Claim 3,

Rivette'137 does not expressly teach, but Eintracht teaches:

display the single logical document as a representation of the at least one document.

(See Eintracht at Column 2, Lines 15- 55, further discloses a notes client/server notes databases (i.e. notes markup resources), that includes the client software application, which is implemented as a web browser plug-in module. The plug-in contains the user interface for navigating *within the document and for handling the notes*. This allows the annotations are transmitted from the server independent of the data transmitted that is related to the viewed document. At the client side, the client application layers the annotations over the image (or document) in accordance with the coordinates of each.

This allows the notes merge and the notes are combined with the document data to form a unitary single logical document - See Eintracht at Fig. 3, and 8 and at Column 1, Lines 50-60.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified the teaching of Rivette'137, to include a means of display the single logical document as a representation of the at least one document as taught by Eintracht, to archive a predictable result of combining the notes with the document data to form a unitary single logical document - See Eintracht at Fig. 3, and 8 and at Column 1, Lines 50-60.

Claims 6, and 20,

Rivette'137 teaches:

the document data and the annotation data is at least one of: XML format, binary format, image data, video data and audio data.

For example Rivette'137 discloses each sub-note includes a content data that which can be any format or combination of formats, such as text, sound, video, image, executable program, tactile, etc (Rivette'137, col. 18, lines 10-30).

Claim 7,

Rivette'137 does not explicitly teach, but Eintracht teaches:

at least one split component, responsive to said single logical document, configured: to extract the annotation data and the document data from the single logical document, to update the at least one annotation in the first data storage from the extracted annotation data, and to update the at least one document in the second data storage from the extracted document data.

(See Eintracht at Column 3, Lines 35-50, discloses a system a system for annotating documents comprising a document file and notes database located on the server, each note associated with a particular document, the notes server operative to store the documents in the document file SEPARATELY from notes stored in the notes database, the notes server receiving one or more notes associated with a particular document from the one or more notes clients and synchronization means within the notes clients and the notes server, the synchronization means for updating the notes server with any notes events processed by the notes clients and for updating the notes client with the results of synchronization updates previously performed by other notes clients since the last synchronization event.

Using the broadest reasonable interpretation, the Examiner equates the claimed **split component… update the at least one document in the second data storage from the extracted document data** as equivalent to store the documents in the document file SEPARATELY from notes stored in the notes database and he

synchronization means for updating the notes server with any notes events processed by the notes clients and for updating the notes client with the results of synchronization updates previously performed by other notes clients since the last synchronization event as taught by Eintracht.

This allows independent management associated annotations to a particular document are treated independently from each other- see Eintracht Column 2, Lines 5-15. This interpretation is supported by the Applicant's disclosure, which states, " *the present invention provides for at least one split component, responsive to the marked-up representation, to extract the annotation data and the document data from the marked-up representation*" see the Applicant Specs Page 6, Line 10-12.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified the teaching of Rivette'137, to at least one split component, responsive to said single logical document, configured: to extract the annotation data and the document data from the single logical document, to update the at least one annotation in the first data storage from the extracted annotation data, and to update the at least one document in the second data storage from the extracted document data as taught by Eintracht, to archive a predictable result of combining the notes with the document data to form a unitary single logical document - See Eintracht at Fig. 3, and 8 and at Column 1, Lines 50-60.

Claim 8,

Rivette'137 teaches:

wherein the at least one annotation indicates an evaluation of at least one legal property relative to the at least one document.

(See Rivette'137 Column 39, lines 5-25, discloses the related projects, such as licensing studies, litigation efforts, opinions of counsel (such as patentability, patent validity, and patent infringement studies); (2) scientific and/or engineering related projects, such as research and development projects; (3) electronic text books, handbooks, user manuals, encyclopedias, and other electronic reference works, including multimedia reference works; (4) auditory and visual documents; (5) virtual library; (6) review course, such as legal bar review course, business review courses, CPA courses, medical review courses, etc.; (7) virtual classrooms; (8) business-related Internet to research; and (9) casual Internet use.)

Claim 9,

Rivette'137 teaches:

at least one version component, configured to at least one of manage a history of changes and maintain at least one separate version for the at least one document and the at least one annotation applied thereto.

(See Rivette'137 Fig. 30 Column 29, Lines 55-65, discloses notes database 508 that stores Notes A, B, and C. As described above with reference to FIG. 8, the user

interface 504 (FIG. 5) creates, updates, and deletes objects in the Web annotation system 502 preferably using the COM interfaces.)

Also, see Rivette' 137 Column 22, Lines 25-40, a notes directory tree or a Web pages directory tree displayed in the notes/Web page directory window 1212, searching for a note or sub-note (as described above with the search button 1230), loading the original Web page (function that shows the user the original version of the Web page).)

Claim 10, Rivette'137 teaches:

> **at least one schema configured to identify at least one tag in at least one of the at least one portion, the at least one document, and the at least one annotation**.

(See Rivette'137 Column 18, Lines 10-30, discloses Linking Sub-Notes To Web Pages allows users to link sub-notes to portions of data object, preferably Web pages, wherein a Web page (or data object) represents any information in any form that can be accessed and/or processed by a computer via the Internet (i.e. such as text files, image files, video files, audio files, computer programs, HTML documents, etc. Accordingly, these Web pages are disparate in both form and content. It is noted the claimed "*schema*" is wherein a Web page (or data object) represents any information in any form that can be accessed and/or processed by a computer via the Internet (i.e. such as text files, image files, video files, audio files, computer programs, HTML documents, etc as taught by Rivette'137.

Claim 13,

Rivette'137 teaches:

> **the at least one annotation being associated with the at least one user, the at least one document being accessible by the plurality of users including the at least one user, and wherein the merge component is further configured, responsive to a request for the at least one document from the at least one, to limit the annotation data included in. the single logical document to annotations associated with the at learnt one user.**

(See Rivette'137 Column 14, Lines 60-67, discloses a user to select a portion of a Web page stored at a Web site or from a local file system (if the portion of the Web page was cached), and links the annotation to the selected portion. The invention receives a request from a user viewing the annotation to display the selected portion linked to the annotation. In response to this request, the invention makes a connection to the Web site, if a connection is not already created, and causes the Web site to send the Web page and present the selected portion. Also note that if the portion of the Web page was cached and thus stored in a local file system, then the present invention does not need to make a connection to a Web site.)

Claims 14, 22 and 27,

the rejection of claims 1, 18, and 25 are fully incorporated, and similarly rejected along the same rationale. In addition Rivette'137 teaches:

at least one annotation includes at least one of: a pre-defined notation, a user-provided text, a user-defined attribute, a reference to a URL, and a reference to one other file.

For example Rivette'137 discloses a web annotation system (item 502 Fig. 5) the plurality components (items 504-509, fig. 5), includes a web page's image and its text, that are associated with notes stores in notes database (item 508), via the Internet (Rivette'137, col. 11, lines 40-65, fig. 5).

Claims 15 and 23, Rivette'137 teaches:

wherein the at least one document is representative of at least one of: a patent document, a trademark document, a copyright document, a product description document, a license document, a sui generis protection document, a design registration document, a trade secret document, and an opinion document.

(See Rivette'137 Column 39, lines 5-25, discloses the related projects, such as licensing studies, litigation efforts, opinions of counsel (such as patentability, patent validity, and patent infringement studies); (2) scientific and/or engineering related projects, such as research and development projects; (3) electronic text books, handbooks, user manuals, encyclopedias, and other electronic reference works,

including multimedia reference works; (4) auditory and visual documents; (5) virtual library; (6) review course, such as legal bar review course, business review courses, CPA courses, medical review courses, etc.; (7) virtual classrooms; (8) business-related Internet to research; and (9) casual Internet use.)

Claims 16 and 24,

Rivette'137 teaches:

> **a report component, responsive to a user, configured to provide a report listing each annotation in the at least one document, and in visual correspondence thereto a summary of each portion in the at least one document that is associated with each annotation;**

(See Rivette'137 Column 39, lines 5-25, discloses the related projects, such as licensing studies, litigation efforts, opinions of counsel (such as patentability, patent validity, and patent infringement studies); (2) scientific and/or engineering related projects, such as research and development projects; (3) electronic text books, handbooks, user manuals, encyclopedias, and other electronic reference works, including multimedia reference works; (4) auditory and visual documents; (5) virtual library; (6) review course, such as legal bar review course, business review courses, CPA courses, medical review courses, etc.; (7) virtual classrooms; (8) business-related Internet to research; and (9) casual Internet use.

Also, see Rivette'137 Fig. 30 Column 29, Lines 55-65, discloses notes database 508 that stores Notes A, B, and C. As described above with reference to FIG. 8, the

user interface 504 (FIG. 5) creates, updates, and deletes objects in the Web annotation system 502 preferably using the COM interfaces.)

Also, see Rivette' 137 Column 22, Lines 25-40, a notes directory tree or a Web pages directory tree displayed in the notes/Web page directory window 1212, searching for a note or sub-note (as described above with the search button 1230), loading the original Web page (function that shows the user the original version of the Web page).

Also, Rivette'137 further teaches:

> **a map component, responsive to the user, configured to list a summary of each portion the at least one document, each annotation in the at least one document including the at least one annotation, and each reference from the at least one portion of the document, including the at least one reference, wherein each annotation and each reference is visually linked to a corresponding portion listed in the summary.**

(See Rivette' 137 Column 22, Lines 25-40, a notes directory tree or a Web pages directory tree displayed in the notes/Web page directory window 1212, searching for a note or sub-note (as described above with the search button 1230), loading the original Web page (function that shows the user the original version of the Web page).

Also, see Rivette'137 Column 7, Lines 45-55, teaches product (CPP) for attaching annotations (or notes and sub-notes) to different data object portions as required by the needs of the user. Using the broadest reasonable interpretation, the Examiner equates the claimed **a map component** as equivalent to attaching

annotations (or notes and sub-notes) to different data object portions as required by the needs of the user as taught by Rivette'137.

Claims 17, and 28,

Rivette'137 teaches:

wherein at least one document is an intelligent property document.

For example Rivette'137 discloses Rivette' invention is applicable to law related project (patentability) (Rivette'137, col.39, lines 10-25).

Claim 21,

the rejection of claims 1, 18, and 25 are fully incorporated, similarly rejected along the same rationale. In addition Rivette'137 teaches:

a schema to identify at least one tag in the at least one element, and logic to determine tags for at least one of the document data, the annotation data, and the at least one marked-up representation.

(See Rivette'137 at col. 20, lines 15-20, discloses that one or more of notes are grouping in a table, whereby all the notes and sub notes from the table can be links to the appropriate portion of the target web page as selected by user using the OLE standard is based on the Component Object Model (COM), Jscript or DHTML for controlling the web annotating system Fig. 10 item 502.

It is noted that, the OLE standard is based on the Component Object Model (COM), Jscript or Dynamic Hypertext Markup Language (DHTML) is the authoring language used to create documents or pages accessible on the Web, whereby Hyperlinks are a common function of the Internet; A hyperlink is an element in an electronic document that links to another place in the same document or to an entirely different document in the Web environment, (see Rivette'137 at col. 2, lines 20-35), can be reasonably interprets as claimed a schema to identify at least one tag in the at least one element, and logic to determine tags; Since Dynamic Hypertext Markup Language (DHTML) is well known as logically linking element in an electronic document that links to another place in the same document or to an entirely different document in the Web environment using tag schema in collaborating with Component Object Model (COM), Jscript using in Rivette'137 web annotating system.

Claim 26,

the rejection of claims 1, 18, and 25 are fully incorporated, similarly rejected along the same rationale. In addition Rivette' 137 teaches:

providing a map listing a summary of each portion in the at least one document, each annotation in the at least one document including the at least one annotation, and each reference from the at least one portion of the document, including the at least one reference, wherein each annotation and each reference is visually linked to a corresponding portion listed in the summary.

(See Rivette'137 at col. 20, lines 15-20, discloses that one or more of notes are grouping in a table, whereby all the notes and sub notes from the table can be links to the appropriate portion of the target web page as selected by user using the OLE standard is based on the Component Object Model (COM), Jscript or DHTML for controlling the web annotating system Fig. 10 item 502.

It is noted that, the OLE standard is based on the Component Object Model (COM), Jscript or Dynamic Hypertext Markup Language (DHTML) is the authoring language used to create documents or pages accessible on the Web, whereby Hyperlinks are a common function of the Internet; A hyperlink is an element in an electronic document that links to another place in the same document or to an entirely different document in the Web environment, (see Rivette'137 at col. 2, lines 20-35), can be reasonably interprets as claimed a schema to identify at least one tag in the at least one element, and logic to determine tags; Since Dynamic Hypertext Markup Language (DHTML) is well known as logically linking element in an electronic document that links to another place in the same document or to an entirely different document in the Web environment using tag schema in collaborating with Component Object Model (COM), Jscript using in Rivette'137 web annotating system.

In addition Rivette'137 does not explicitly teach, but Eintracht teaches:

in visual correspondence thereto a summary of each portion in the at least one document that is in associated with each annotation.

(See Eintracht at Column 2, Lines 15- 55, discloses a notes client/server notes databases (i.e. notes markup resources), that includes the client software application, which is implemented as a web browser plug-in module. The plug-in contains the user interface for navigating *within the document and for handling the notes.* This allows the annotations are transmitted from the server independent of the data transmitted that is related to the viewed document. At the client side, the client application layers the annotations over the image (or document) in accordance with the coordinates of each. This allows the notes merge and the notes are combined with the document data to form a unitary single logical document - See Eintracht at Fig. 3, and 8 and at Column 1, Lines 50-60.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified the teaching of Rivette'137, to include a means in visual correspondence thereto a summary of each portion in the at least one document that is in associated with each annotation as taught by Eintracht, to archive a predictable result of combining the notes with the document data to form a unitary single logical document - See Eintracht at Fig. 3, and 8 and at Column 1, Lines 50-60.

Claim 54,

Rivette'137 teaches:

> **an annotation tool, responsive to a user, configured to input annotation data to be applied, to the at least one document, including a selection require to select at least one element of the document data to be annotated, and a mark-up resource to at least one of add and edit annotation data corresponding to the at least one element;**

(See Rivette'137 Column 4, Lines 55-65, discloses a system, method, and computer program product of linking annotations (or notes or sub-notes in a note) to Web pages. The invention enables a user to select a portion of a Web page stored at a Web site or from a local file system (if the portion of the Web page was cached). The invention creates an annotation, and links the annotation to the selected portion. The invention receives a request from a user viewing the annotation to display the selected portion linked to the annotation.

Also, see Rivette'137 Column 12 Line 55 → Column 13 Line 5, discloses OLE, DHTML and windows operations are mentioned in this disclosure. Such operations include selecting text, opening files, moving between windows, resizing windows, editing documents, etc. Such operations are well known and are described in many publicly available documents, such as Microsoft Word for Windows Users Guide, 1994, incorporated herein by reference in its entirety.)

Also, Rivette'137 further teaches:

> **an edit tool, responsive to a user, configured to select the at least one element, and to edit the at least one element, including a representation of the at least one selected element, and a representation of the at least one annotation data; and a reference tool, configured to determine at least one reference to the at least one element and at least an other element of at least one document, and to enable the at least one reference to be traversed by the user,**

(See Rivette'137 Column 4, Lines 55-65, discloses a system, method, and computer program product of linking annotations (or notes or sub-notes in a note) to Web pages. The invention enables a user to select a portion of a Web page stored at a Web site or from a local file system (if the portion of the Web page was cached). The invention creates an annotation, and links the annotation to the selected portion. The invention receives a request from a user viewing the annotation to display the selected portion linked to the annotation.

Also, see Rivette'137 Column 12 Line 55 → Column 13 Line 5, discloses OLE, DHTML and windows operations are mentioned in this disclosure. Such operations include selecting text, opening files, moving between windows, resizing windows, editing documents, etc. Such operations are well known and are described in many publicly available documents, such as Microsoft Word for Windows Users Guide, 1994, incorporated herein by reference in its entirety.

Also, Rivette' 137 Column 19 Lines 55-65, teaching the linking mechanism 1038 of the present invention enables users to easily traverse through related Web pages 1020.)

(10) Response to Argument

Brief description of cited prior art:

Rivette et al. [hereinafter Rivette'137] relates to organizing, ***bi-directionally linking, making annotations*** (or notes and sub-notes) on, and ***maintaining disparate Web pages*** [such as ***patentability, patent validity, and patent infringement*** studies (see Rivette'137 at Column 39, lines 5-25)]. Bi-directional links as described in this application allow the user to determine the relative location of links on Web page of the Internet or an intranet. Bi-directional links as described in this application also allow the user to select a portion or section of the Web page and then make annotations on the portion of the Web page selected. Bi-directional links as described in this application also link the user to the location of the selected Web page from the note or sub-note about the selected Web page. Once the Web page is placed in annotation mode, the existing bi-directional links appear beside the portion of the Web page selected, beside the annotation (or note/sub-note), and content field of the annotation, and beside the organizational storage of the annotation. in fact the method of linking notes to Web pages operates by ***enabling a user to select a portion of a Web page***, creating a annotation, ***linking the annotation to the selected portion***, receiving a request from a user viewing the annotation to display the selected portion linked to the annotation, and invoking an application, if the application is not already invoked,

and for ***causing the application to load the Web page and present the selected portion***. [This is generally discloses at column 5 lines 10-35 and at the Abstract of Rivette'137 and at Fig. 10] illustrates the linking capabilities of the Note/Sub-Note Organization and Linking Sub-Notes to Web Pages;

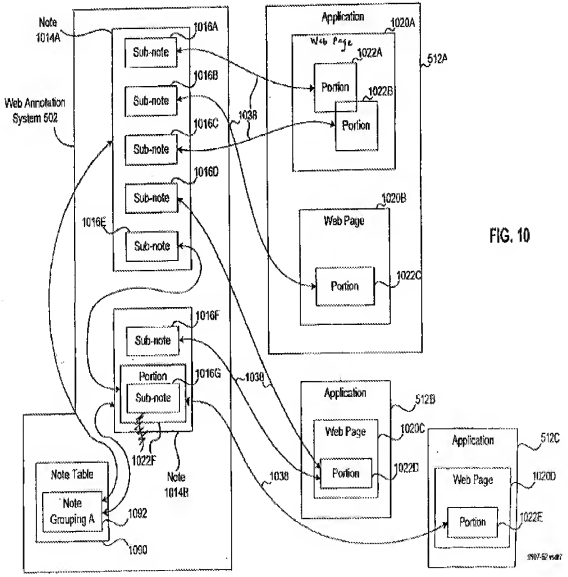

FIG. 10

Eintracht et al relates to ***synchronizing/updating local client notes with annotations*** previously made by other clients in a notes database [Eintracht at the title] whereby the collaborative document annotation uses notes or annotations associated with a document are stored on a web server. Each document may contain more than one page, wherein each page is annotated independently of the other. The documents and associated ***annotations are treated independently*** from each other [Eintracht at column 6 lines 30-55, and at column 6 line 55 through column 7 line 10 and figure(s) 1A through C.] Also Eintracht further discloses the merging process of the client note event information with the Notes Database, and then the client merges the notes list with its local notes database (step 170). The display is then refreshed and the Notes Client is ready to receive and process input from the user once again (step 172) whereby ***a single document window 10*** in which an image 14 is displayed together with notes item 16(s). This is generally discloses at [column 16 lines 1-45 and at figure(s) 3, 9-10 and 1A-->1C of Eintracht].

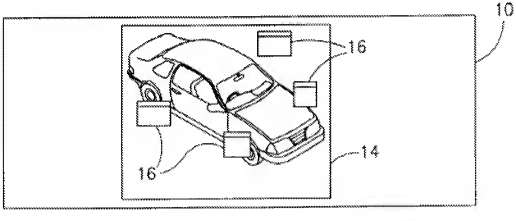

FIG.1B

Response to Arguments:

Beginning on page 11/19 of the appeal brief dated 12/05/2008 (hereinafter App. Br.), Appellant argues the following issues, which are accordingly addressed below.

Regarding rejections of independent claims 1, 25, and dependent claims 2-3, 6, 8-10, 13-17, 26-28 and 54:

Appellant asserts that the proposed combination [of Rivette'137 and Eintracht] when considered as a whole does not teach or suggest the claimed feature that "*to combine the annotation data and the document data to form* ***a unitary single logical document****, the single logical document displaying the* ***annotation embeded seamlessly in the document data***" as recited in claim(s) 1 and 25- (App. Br. Page 12 Paragraph No. 1), because "stick" notes and "annotation with seams layered on the document data" of Eintracht is clearly not "the annotation embede seamlessly" and clearly not "unitary single logical document" as claimed, See App. Br. Page 13 llast paragraph and Page 14 Para 1 and 2.

The Examiner disagrees.

For purposes of responding to Appellant's argument, the examiner will assume that the Appellant is arguing for the patentability of Claim(s) 1 and 25.

As discuss above and in previously presented Office Action mailed 01/23/2008. Specifically, **Rivette'137** relates to organizing, ***bi-directionally linking, making***

annotations (or notes and sub-notes) on, and ***maintaining disparate Web pages*** [such as ***patentability, patent validity, and patent infringement*** studies (see Rivette'137 at Column 39, lines 5-25)]. Bi-directional links as described in this application allow the user to determine the relative location of links on Web page of the Internet or an intranet. Bi-directional links as described in this application also allow the user to select a portion or section of the Web page and then make annotations on the portion of the Web page selected. Bi-directional links as described in this application also link the user to the location of the selected Web page from the note or sub-note about the selected Web page. Once the Web page is placed in annotation mode, the existing bi-directional links appear beside the portion of the Web page selected, beside the annotation (or note/sub-note), and content field of the annotation, and beside the organizational storage of the annotation. in fact the method of linking notes to Web pages operates by ***enabling a user to select a portion of a Web page***, creating a annotation, ***linking the annotation to the selected portion***, receiving a request from a user viewing the annotation to display the selected portion linked to the annotation, and invoking an application, if the application is not already invoked, and for ***causing the application to load the Web page and present the selected portion***. [This is generally discloses at column 5 lines 10-35 and at the Abstract of Rivette'137 and at Fig. 10] illustrates the linking capabilities of the Note/Sub-Note Organization and Linking Sub-Notes to Web Pages;

In addition, "What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103." KSR Int'l Co. v. Teleflex, Inc., 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be "more than the predictable use of prior art elements according to their established functions." Id. at 1740.

As recognized by the Examiner, Rivette'137does not expressly teach the use of combine the annotation data and the document data to form a unitary single logical document, the single logical document displaying the annotation embeded seamlessly in the document data such as recited in independent claim (s) 1 and 25. On the other hand, in what is fairly characterized as analogous art in accordance with the above-noted case law, **Eintracht** et al relates to ***synchronizing/updating local client notes with annotations*** previously made by other clients in a notes database [Eintracht at the title] whereby the collaborative document annotation uses notes or annotations associated with a document are stored on a web server. Each document may contain more than one page, wherein each page is annotated independently of the other. The documents and associated ***annotations are treated independently*** from each other [Eintracht at column 6 lines 30-55, and at column 6 line 55 through column 7 line 10 and figure(s) 1A through C.] Also Eintracht further discloses the merging process of the client note event information with the Notes Database, and then the client merges the notes list with its local notes database (step 170). The display is then refreshed and the Notes Client is ready to receive and process input from the user once again (step 172)

whereby ***a single document window 10*** in which an image 14 is displayed together with notes item 16(s). This is generally discloses at [column 16 lines 1-45 and at figure(s) 3, 9-10 and 1A-->1C of Eintracht].

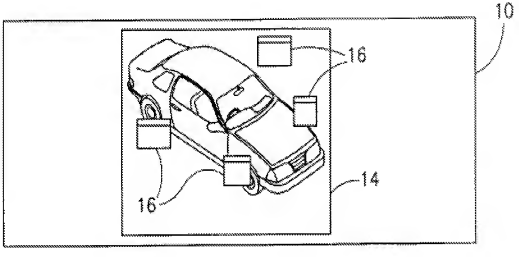

FIG.1B

In addition, in fact Eintracht's notes client/server notes databases (i.e. notes markup resources), that includes the client software application, which is implemented as a web browser plug-in module. The plug-in contains the user interface for ***navigating within the document and for handling the notes***. This allows the annotations are transmitted from the server independent of the data transmitted that is related to the viewed document. At the client side, the client application layers the annotations over the image (or document) in accordance with the coordinates of each. This allows the

notes merge and the notes are combined with the document data to form a unitary single logical document - See Eintracht at Fig. 3, and 8 and at Column 1, Lines 50-60.

Using the broadest reason able interpretation, the Examiner reads the claimed the annotation data embedded seamlessly in the document data as equivalent to the plug-in contains the user interface for ***navigating within the document and for handling the note and*** **synchronizing/updating local client notes with annotations** previously made by other clients in a notes database. The above interpretation is supported by the appellant's current disclosure, states, "*Further, the mark-up data* ***preferably is seamlessly associated with the document information****, and according to one or more embodiments of the present invention is preferably presented to the user as a unitary document. Despite the unitary appearance, when the user is finished working on this document, the document and mark-up information optionally is broken into components, optionally each being stored in the appropriate and/or separate storage. Optionally, the document and mark-ups are stored together."* (See appellant's disclosure at page 32 lines 12-17).

Moreover, Also it is noted the appellant's disclosure does not positively recited the details written decryptions of "*the annotation data embedded seamlessly in the document data*" as claimed [see appellant's disclosure at page 32 lines 12-17].

Therefore, the artisan would have found it obvious to have utilized the concept of synchronizing/updating local client notes with annotations previously made by other clients in a notes database to display the Notes Client/server and the local images in a

single document window of Eintracht in the corresponding to the method directed to bi-directionally linking, making annotations (or notes and sub-notes) on, and maintaining disparate Web pages [such as patentability, patent validity, and patent infringement studies] relates to Rivette'137, this combination would provides method of linking notes to Web pages operates by enabling a user to select a portion of a Web page, creating a annotation, linking the annotation to the selected portion, receiving a request from a user viewing the annotation to display the selected portion linked to the annotation, and invoking an application, if the application is not already invoked, and for causing the application to load the Web page and present the selected portion. [This is generally discloses at column 5 lines 10-35 and at the Abstract of Rivette'137 and at Fig. 10] and further enabling the combining the notes with the document data to form a unitary single logical document - See Eintracht at Fig. 3, and 8 and at Column 1, Lines 50-60 and at the [Abstract] of Eintracht.

Thus, Rivette and Eintracht clearly disclose to combine the annotation data and the document data to form a unitary single logical document, the single logical document displaying the annotation embeded seamlessly in the document data, as recited in independent claim(s) 1, 25 and provided proper reasons to combine.

Accordingly, dependent claim(s) 2-3, 6, 8-10, 13-17, 26-28 (App. Br. Page 16) a and claim 54 (App. Br. Page 19) are fully incorporated similar subject of claim(1) and 25 cited above, and are similarly rejected along the same rationale. Thus Rivette and

Eintracht clearly disclose all the limitation of claims 2-3, 6, 8-10, 13-17, 26-28, 54 and provided proper reasons to combine.

Regarding rejections of independent claim 18, dependent claims 7, 20-24:

Appellant asserts that the proposed combination [of Rivette and Eintracht] when considered as a whole does not teach or suggest the claimed feature that "*merge component and the split component*" as recited in claim 18- (App. Br. Page 16 bottom hafl of the page), because Eintricht's "*only addresses collaboration with asynchronous exchange of annotations, but discloses nothing about changes to the document itself*" as claimed, See App. Br. Page 17 lines 19-20.

The Examiner disagrees.

For purposes of responding to Appellant's argument, the examiner will assume that the Appellant is arguing for the patentability of Claim 18.

As discuss above and in previously presented Office Action mailed 01/23/2008. Specifically, **Rivette'137** et al. relates to organizing, ***bi-directionally linking, making annotations*** (or notes and sub-notes) on, and ***maintaining disparate Web pages*** [(see Rivette at Column 39, lines 5-25)].

As recognized by the Examiner, Rivette'137 does not expressly teach the use of merge and split components to combine the annotation data and the document data to form a unitary single logical document, the single logical document displaying the

annotation embeded seamlessly in the document data such as recited in independent claim (s) 1 and 25. On the other hand, in what is fairly characterized as analogous art in accordance with the above-noted case law, **Eintracht** et al relates to ***synchronizing/updating local client notes with annotations*** previously made by other clients in a notes database [Eintracht at the title] whereby the collaborative document annotation uses notes or annotations associated with a document are stored on a web server. Each document may contain more than one page, wherein each page is annotated independently of the other. The documents and associated ***annotations are treated independently*** from each other [Eintracht at column 6 lines 30-55, and at column 6 line 55 through column 7 line 10 and figure(s) 1A through C.] Also Eintracht further discloses the ***merging process*** of the client note event information with the Notes Database, and then the client merges the notes list with its local notes database (step 170). The display is then ***refreshed and the Notes Client is ready to receive and process input from the user once again (step 172) whereby a single document window 10 in which an image 14 is displayed together with notes item 16(s)***. This is generally discloses at [column 16 lines 1-45 and at figure(s) 3, 9-10 and 1A-->1C of Eintracht]. In fact, figure 1A of Eintracht shows the image without the annotation while figure 1 B in the other hand shows the client merges the notes list with its local notes database (step 170). The display is then refreshed and the Notes Client is ready to receive and process input from the user once again (step 172) whereby a single document window 10 in which an image 14 is displayed together with notes item 16(s). This allows the notes merge and the notes are combined with the document data

to form a unitary single logical document - See Eintracht at Fig. 3, and 8 and at Column 1, Lines 50-60.

Using the broadest reasonable interpretation, the Examiner equates the claimed **split component** as equivalent to store the documents in the document file SEPARATELY from notes stored in the notes database and he synchronization means for updating the notes server with any notes events processed by the notes clients and for updating the notes client with the results of synchronization updates previously performed by other notes clients since the last synchronization event as taught by Eintracht.

This allows independent management associated annotations to a particular document are treated independently from each other- see Eintracht Column 2, Lines 5-15. This interpretation is supported by the Appellant's disclosure, which states, " merged document...*When that work is complete or the user otherwise is done, then the document is split up into two (or more) different streams corresponding to the mark-up(s) and the document(s). Preferably, the document is in XML format, but could be in other formats.*" see the Applicant Specs Page 32, Line 19-25.

Therefore, the artisan would have found it obvious to have utilized the concept of store the documents in the document file SEPARATELY from notes stored in the notes database and he synchronization means for updating the notes server with any notes events processed by the notes clients and for updating the notes client with the results of synchronization updates previously performed by other notes clients since the last

synchronization event as taught by Eintracht in the corresponding to the method directed to bi-directionally linking, making annotations (or notes and sub-notes) on, and maintaining disparate Web pages [such as patentability, patent validity, and patent infringement studies] relates to Rivette'137, this combination would provides method of linking notes to Web pages operates by enabling a user to select a portion of a Web page, creating a annotation, linking the annotation to the selected portion, receiving a request from a user viewing the annotation to display the selected portion linked to the annotation, and invoking an application, if the application is not already invoked, and for causing the application to load the Web page and present the selected portion. [This is generally discloses at column 5 lines 10-35 and at the Abstract of Rivette'137 and at Fig. 10] and further enabling the combining the notes with the document data to form a unitary single logical document - See Eintracht at Fig. 3, and 8 and at Column 1, Lines 50-60 and at the [Abstract] of Eintracht.

Thus, Rivette and Eintracht clearly disclose the merge and split components, as recited in independent claim 18 and provided proper reasons to combine.

Accordingly, dependent claim(s) 7, 20-24 (App. Br. Page 19 lines 5-8) are fully incorporated similar subject of claim 18 cited above, and are similarly rejected along the same rationale. Thus Rivette'137 and Eintracht clearly disclose all the limitation of claims 7, 20-24 and provided proper reasons to combine.

Therefore the Examiner respectfully maintains the rejection of claims 1-3, 6-10, 13-18, 20-28 and 54 and should be sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Quoc A. Tran/
Examiner, Art Unit 2176

Conferees:

/DOUG HUTTON/
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